

RECEIVED
CENTRAL FAX CENTER

04-22:40 p.m.

07-08-2008

14 / 18

Appl. No. 10/005,299
Amdt. dated July 8, 2008
Reply to Office Action of April 8, 2008

JUL 08 2008

REMARKS/ARGUMENTS

Claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97 are presented for the Examiner's consideration. Claims 4, 5, 8, 22, 26, 47, 53-82, 86, and 87 were previously withdrawn and claims 27-43 and 48-52 were previously canceled. Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Chen does not teach or suggest each and every element of the claimed invention.

By way of the Office Action mailed April 8, 2008, the Examiner rejects claims 1-3, 6-7, 9-21, 44-46, 83-85, and 88-97 under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,261,679 to Chen et al. (hereinafter "Chen"). This rejection is respectfully **traversed** to the extent that it may apply to the presently presented claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

With respect to independent claims 1, 17, 44, and 83, the Examiner concludes that Chen provides an absorbent composition comprising an absorbent material and a cooling compound, without citing evidence that Chen's absorbent includes a cooling compound. The Examiner points to col. 8, lines 18-24 and col. 17, lines 16-19 as alleged evidence of Chen disclosing a cooling compound. The former of these refers to toxicologically-acceptable magnesium salts used to render hydrophobic fibers substantially or partially hydrophilic through surface modification of the fibers. Even if there existed a toxicologically-acceptable magnesium salt that is endothermic as defined in the present application, and the Examiner has not provided evidence that there is, Chen discloses nothing about the

Appl. No. 10/005,299
Amdt. dated July 8, 2008
Reply to Office Action of April 8, 2008

conditions, amounts, and processes of and under which such substance would be a cooling compound. Chen merely hints at treating a fiber with a magnesium salt; it does not disclose a cooling compound and it certainly does not disclose a cooling compound having an endothermic effect as claimed in the present application.

Also, contrary to the Examiner's assertion that Chen in the latter passage discloses ammonium bicarbonate as a cooling compound to produce an endothermic effect, Chen does not disclose the inclusion of ammonium bicarbonate with Chen's absorbent. Chen merely discloses the potential ability to use ammonium carbonate in the process of forming a foam material. Ammonium bicarbonate decomposes to form a gas upon heating, thus creating spaces in the foam material. Even if ammonium carbonate could be used to produce a cooling effect as defined in the present application, and the Examiner has not provided evidence that there is, Chen discloses nothing about the conditions, amounts, and processes of and under which such substance would be a cooling compound. Chen merely hints at using ammonium bicarbonate to form a foam; it does not disclose a cooling compound and it certainly does not disclose a cooling compound having an endothermic effect as claimed in the present application.

Further, one skilled in the art would understand that ammonium bicarbonate is entirely inappropriate to use in conjunction with an absorbent composition as defined in the present application. Hawley's Condensed Chemical Dictionary, 12th Edition, 1993, states that ammonium bicarbonate evolves irritating fumes on heating to 35 degrees C and decomposes at 36-60 degrees C.

Nowhere in these passages nor anywhere else does Chen disclose an absorbent composition including a cooling compound, wherein the cooling compound has an endothermic effect as claimed in the present application.

Contrary to the Examiner's claim, Chen does not disclose, teach, or suggest an absorbent composition including, *inter alia*, a cooling compound of any sort, particularly one such as that described and claimed in the instant application. In fact, Chen does not disclose, teach, or suggest a cooling effect or an endothermic effect in any respect. The specific passages in Chen referenced by the Examiner have nothing to do with a cooling effect or an endothermic effect of any kind.

Appl. No. 10/005,299
Amdt. dated July 8, 2008
Reply to Office Action of April 8, 2008

More specifically, claim 1 is directed to an absorbent composition including a water-swellaable, water-insoluble absorbent material; and a cooling compound, wherein the cooling compound has an endothermic effect, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, Chen does not disclose an absorbent composition including a cooling compound, wherein the cooling compound has an endothermic effect, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, Chen does not disclose a cooling effect or an endothermic effect in any respect.

Claim 17 is directed to an absorbent composition including a water-swellaable, water-insoluble acidic absorbent material; and a cooling compound, wherein the cooling compound has an endothermic effect and is a basic compound capable of neutralizing the acidic absorbent material, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, Chen does not disclose an absorbent composition including a cooling compound, wherein the cooling compound has an endothermic effect and is a basic compound capable of neutralizing the acidic absorbent material, wherein the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, Chen does not disclose a cooling effect or an endothermic effect in any respect.

Claim 44 is directed to a method for producing an absorbent composition capable of exhibiting a cooling effect, the method including selecting a water-swellaable, water-insoluble absorbent material; selecting a cooling compound having an endothermic effect; and combining the absorbent material and the cooling compound to form the absorbent composition such that the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling

Appl. No. 10/005,299
Amdt. dated July 8, 2008
Reply to Office Action of April 8, 2008

effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. Contrary to the Examiner's claim, Chen does not disclose selecting a cooling compound having an endothermic effect, nor does Chen disclose combining the absorbent material and the cooling compound to form the absorbent composition such that the absorbent composition exhibits an absorbent capacity of at least 10 grams of 0.9 wt% NaCl saline per gram of the absorbent composition and a cooling effect of at least a 2°C reduction in temperature of at least a portion of the absorbent composition. In fact, Chen does not disclose a cooling effect or an endothermic effect in any respect.

Claim 83 is directed to an absorbent composition including a superabsorbent material; and a sufficient amount of cooling compound such that the absorbent composition is adapted to provide a cooling effect in at least a portion of the composition while absorbing aqueous liquid. Contrary to the Examiner's claim, Chen does not disclose a sufficient amount of cooling compound such that the absorbent composition is adapted to provide a cooling effect in at least a portion of the composition while absorbing aqueous liquid. In fact, Chen does not disclose a cooling effect in any respect.

With respect to dependent claims 2, 3, 6, 7, 9-16, 18-21, 45, 46, 84, 85, and 88-97, the Examiner states that the "absorbent material and cooling compound may be acidic and basic, respectively" without providing a citation to where this might be found in Chen, over and above the total lack of a cooling compound as discussed above. As a result, the entire subject matter of these claims is attributed to "discovering the optimum value requir[ing] only a level of ordinary skill in the art." One cannot "optimize" the pH etc. of certain elements (e.g. a cooling compound) if those elements are non-existent in the prior art, as discussed above. The Examiner also states that the the temperature reduction may be modified to provide the desired effect because "the general conditions of a claim are disclosed in the prior art" without providing a citation to where such general conditions might be found in Chen. One cannot "optimize" the temperature reduction disclosed in the prior art if a temperature reduction is not disclosed in the prior art.

The Examiner has made such assertions of optimizing pH ranges and temperature reductions, for example, without providing a *prima facie* case that such ranges and reductions are known in the art. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Appl. No. 10/005,299
Amdt. dated July 8, 2008
Reply to Office Action of April 8, 2008

JUL 08 2008

(*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007).)

In addition, the Examiner's position appears to be the very position rejected by the court in *In re Antonie* 195 USPQ 6 (CCPA 1977). In particular, the court noted that an assertion that it would always be obvious to one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system is improper "if there is no evidence in the record that the prior art recognized that particular parameter affected the result" (*Id. at 8 (emphasis added)*). Thus, the court made it clear that the recognition of a particular parameter as a general condition must come from the cited references, in this case, Chen.

In the alternative, claims 2, 3, 6, 7, 9-16, 18-21, 45, 46, 84, 85, and 88-97 are dependent claims that depend from an allowable independent claim, and are thus allowable themselves for the reasons stated above with respect to independent claims 1, 17, 44, and 83.

In view of the remarks set forth in this section, Applicant respectfully submits that claims 1-3, 6, 7, 9-21, 44-46, 83-85, and 88-97 are in condition for allowance and respectfully requests favorable consideration and the timely allowance of those claims.

For the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

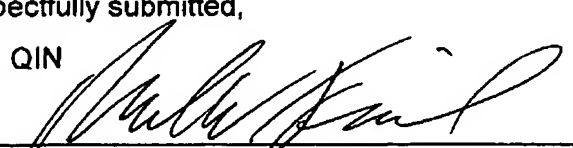
Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: (920) 721-8863.

Respectfully submitted,

JIAN QIN

By



Randall W. Fieldhack
Registration No.: 43,611
Attorney for Applicant(s)